

Attorney Docket: 18915-US2  
Serial No. 10/052,417  
Response to Action mailed February 15, 2006  
Page 12 of 14

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## REMARKS/ARGUMENTS

AUG 15 2006

### Status of the Claims

Claims 1-3, 6-8, 11-13, 16-18, 21-23, 26, 27, 31-36, 39-42, 45-47, and 50-52 are pending. Claims 1, 11, 21, 31-33, 39, 45, and 50 have been amended herein. These clarifying amendments introduce no new matter and support is replete throughout the specification as originally filed. Exemplary support for the amended claims is provided in, e.g., Table I of the subject application.

These amendments are made without prejudice and are not to be construed as an abandonment of the previously claimed subject matter or agreement with any objection or rejection of record. Applicants respectfully request that all of these amendments be entered.

### 35 U.S.C. § 102

The Action rejects claims 1-3, 6-8, 11-13, 16-18, 21-23, 26, 27, 31, 33-36, 39-42, and 45-47 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Pat. No. 6,265,193 (hereinafter, Brandis I) and by U.S. Pat. Pub. No. US 2002/0164591 (hereinafter, Brandis II). Brandis II is a division of application no. 09/041,878, now Brandis I.

As a general matter, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In other words, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As amended herein, each of the pending independent claims of the subject application (i.e., claims 1, 11, 21, 31-33, 39, 45, and 50) provides that the polymerase is selected from a *Thermus* species other than *Thermus aquaticus*. Neither of the cited publications expressly teaches or suggests the particular amino acid sequences recited in these independent claims for *Thermus* species other than *Thermus aquaticus*. As a consequence, neither of the publications anticipates any of these independent claims. It necessarily follows that claims depending from these independent claims are also not anticipated by either of the cited publications. Since all of the claims of the subject application are not anticipated by

either Brandis I or Brandis II, Applicants respectfully request that all of these rejections be withdrawn.

### 35 U.S.C. § 103

The Action rejects claims 32 and 50-52 as allegedly being obvious over Brandis I or II in view of U.S. Pat. No. 5,939,292 (hereinafter, Gelfand). Applicants respectfully traverse for the reasons specified below.

To establish a *prima facie* case of obviousness, the cited art must teach or suggest all the claim limitations. See, MPEP § 2142. For the reasons specified above, neither Brandis I nor Brandis II explicitly teaches or suggests the particular amino acid sequences recited in any of the independent claims for *Thermus* species other than *Thermus aquaticus*. The passages from Gelfand cited in the Action do not supply these missing limitations. Therefore, the Action fails to establish a *prima facie* case of obviousness with respect to claims 32 and 50 or any claims dependent therefrom. Since all of the claims of the subject application are non-obvious over the cited art, Applicants respectfully request that all of these rejections be withdrawn.

### CONCLUSION

In view of the foregoing, Applicants believe that all claims of the subject application are neither anticipated nor obvious. Accordingly, the issuance of a formal notice of allowance at an early date is respectfully requested. Applicants hereby request a three-month extension of time for responding to the Office Action. The Commissioner is authorized to charge the extension of time fee under 37 CFR 1.17, to Account No. 50-0812. The Commissioner is further authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 50-0812.

If the Examiner believes a telephone conference would be of further assistance, please telephone the undersigned at 510-814-2786.

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Respectfully submitted,



Christopher C. Sappenfield  
Reg. No: 45,073

Deposit Account No.: 50-0812

Attachments:

- 1) A transmittal sheet;
- 2) Copy of previously submitted Power of Attorney (5 pages).

2005 02/14 13:36 FAX 415 576 0300

@001/005

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Atty Docket No. 022101-000320US

PTO FAX NO.: 703-872-9306

ATTENTION: Examiner Jehanne Souaya Sitton

Group Art Unit 1634

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FEB 14 2005

**OFFICIAL COMMUNICATION**  
**FOR THE PERSONAL ATTENTION OF**  
**EXAMINER Sitton, Jehanne Souaya**

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that the following documents in re Application of David Harrow GELFAND, et al., Application No. 10/052,417, filed January 17, 2002 for THERMOSTABLE DNA POLYMERASES INCORPORATING NUCLEOSIDE TRIPHOSPHATES LABELED WITH FLUORESCHEIN FAMILY DYES are being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Documents Attached

1. Copy of Revocation and POA By Assignee, Schedule A, Statement Under 3.73(b), and Return Postcard evidencing receipt by the USPTO on May 17, 2004. Please make these of record in this case.

Number of pages being transmitted, including this page: 5

Dated: February 14, 2005

  
Sherbonné Barnes-Anderson, Prosecution Paralegal

**PLEASE CONFIRM RECEIPT OF THIS PAPER BY  
RETURN FACSIMILE AT (415) 576-0300**

TOWNSEND and TOWNSEND and CREW LLP  
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RMS Patent Department

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FEB 14 2005

PTO/SB/82 (09-03)

**REVOCATION OF POWER OF  
ATTORNEY WITH  
NEW POWER OF ATTORNEY  
AND  
CHANGE OF CORRESPONDENCE ADDRESS**Application/Patent  
Numbersas set forth in Schedule A appended  
hereto

Filing/Issue Dates

as set forth in Schedule A appended  
heretoAttorney Docket  
Numbersas set forth in Schedule A appended  
hereto

I hereby revoke all previous powers of attorney given in the above-identified application:

☐ A Power of Attorney is submitted herewith.

OR

☒ I hereby appoint the practitioners associated with the Customer Number:

41504

☒ Please change the correspondence address for the above-identified application to:☒ The address associated with  
Customer Number: 41504

OR

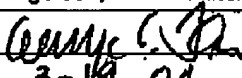
<input type="checkbox"/> Firm or Individual Name					
Address					
Address					
City		State		ZIP	
Country					
Telephone		Fax			

I am the:

☐ Applicant/Inventor.☒ Assignee of record. See 37 CFR 3.71.

Statements under 37 CFR 3.73(b) are enclosed. (Form PTO/SB/96)

**SIGNATURE of Applicant or Assignee of Record**

Name	George Jen, Senior Patent Counsel		
Signature			
Date	3-14-04	Telephone	510.814.2766

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ Total of forms are submitted.

60135808 v1

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## Schedule A (as attached to PTO/SB/81)

Application No. Filing Date	Patent No. Issue Date	Attorney Docket No.
09/146,631 September 3, 1998	6,346,379 February 12, 2002	022101-000310US
09/270,933 March 16, 1999	6,365,375 April 2, 2002	022101-000500US
09/204,208 December 1, 1998	6,399,320 January 4, 2002	022101-000400US
09/623,326 February 6, 2001	6,607,883 August 19, 2003	022101-001100US
09/904,420 July 12, 2001	6,656,691 December 2, 2003	022101-001210US
10/003,998 November 14, 2001	6,664,064 December 16, 2003	022101-002200US
09/269,858 June 10, 1999	6,692,932 February 17, 2004	022101-000600US
09/823,711 March 30, 2001		022101-001700US
09/823,712 March 30, 2001		022101-001900US
10/007,389 October 29, 2001		022101-002100US
10/052,417 January 17, 2002		022101-000320US
10/072,436 February 5, 2002		022101-000410US
10/087,082 February 28, 2002		022101-000510US
10/087,631 March 1, 2002		022101-001500US
10/189,956 July 3, 2002		022101-002410US
10/300,576 November 19, 2002		022101-002310US
10/322,138 December 17, 2002		022101-000910US
10/355,532 January 30, 2003		022101-000330US
10/401,403 March 26, 2003		022101-002510US
10/419,022 April 17, 2003		022101-001510US
10/455,058 June 4, 2003		022101-001220US

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PTO/SB/96 (08-03)

Attorney Docket No. 022101-000320US

**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: Roche Molecular Systems, Inc.

Application No./Patent No.: 10/052,417

Filed/Issue Date: January 17, 2002

Entitled: Thymosinable DNA Polymerases Incorporating Nucleoside Triphosphates Labeled With Fluorescein...

Roche Molecular Systems, Inc., a corporation

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.  
The extent (by percentage) of its ownership interest is \_\_\_\_\_ %

In the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 8901, Frames 0619-0627, or for which a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.8]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

3-19-04

Date

510.614.2786

Telephone number

George Jan

Typed or printed name

George Jan

Signature

Senior Patent Counsel

Title

60135822 v1